

REMARKS

Claims 22-24 have been canceled without prejudice or disclaimer. New claims 31-33 have been added. Accordingly, claims 1-21 and 25-33 are pending in the application.

Response to Restriction Requirement

In response to the Restriction Requirement mailed December 28, 2005, Applicants hereby elect the species of new claims 31-33 for further prosecution on the merits. The remaining claims, claims 1-21 and 25-30 are all readable on the elected species as including a pouch having a contracted configuration that is able to expand to an extended configuration and return to the retracted configuration.

Further, Applicants respectfully traverse any renewed restriction requirement for the pending claims, as amended, for the following reasons.

According to MPEP 803, if the search and examination of all the claims in the application can be made without serious burden, the examiner must examine them on the merits even though they include claims to independent or distinct inventions. A serious burden on the examiner must be shown in the Restriction Requirement by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.

No such showing has been made in the Restriction Requirement of December 28, 2005, with respect to Groups I, II, and III, or for justifying separation of Group I into multiple subspecies, namely Groups IV and V. The Restriction Requirement

does not demonstrate separate classification, or separate status in the art, or a different field search as defined in MPEP § 808.02, to justify restriction of the claims. The Office Action itself clearly states that all of the claims are directed to inventions classified in a single subclass, namely, class 128, subclass 830. Thus, no showing of separate classification, separate status in the art, or a different field of search has been demonstrated, as required by MPEP 803. Additionally, a search of USPTO records for subclass 128/830 was conducted on January 26, 2006, using the USPTO website. This search showed that there are currently 134 US Patents and 27 US Patent Publications classified in subclass 128/830. Thus, it is difficult to understand how searching a subclass with only 161 patent documents classified therein can constitute a "serious search burden" on the examiner.

Further, while the Office Action cites MPEP 806.05(c) for supporting the restriction requirement, as showing distinct inventions, the Office Action ignores the first requirement of MPEP 806.05(c), namely, that "To support a requirement for restriction between combination and subcombination inventions, **both** two-way distinctness **and** reasons for insisting on restriction are necessary, i.e., there would be a serious search burden as evidenced by separate classification, status, or field of search" (MPEP 806.05(c) emphasis added). Thus, while the Restriction Requirement states that the search required for Group I is not the same as that required for Group II, and nor for Group III, the Office Action fails to show how this is a serious search burden. Accordingly, the claims currently pending in the application

all demonstrate a suitable unity of invention for examination, and the requirement for restriction to is believed to be traversed.

Further, all the claims are believed to be allowable, as the prior art does not teach a female condom that is able to extend from a contracted state during insertion of the penis, and then spring back to the contracted state during withdrawal of the penis.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests timely examination of the pending claims in this case and issuance of a Notice of Allowance.

Respectfully submitted,



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